

## DETAILED ACTION

### *Election/Restrictions*

Claims 45-66 and 79-170 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 21, 2008.

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-44 and 67-78 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The preamble of independent claims 1, 23, and 67 recites the term "a probe **placed in contact** with a cornea." One cannot positively claim any part of a human body. Correction such as --a probe adapted to be placed in contact with a cornea-- is suggested.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-12, 14-20, 21-28, 30-34, 36-42, 44, 67-71, and 73-78 are rejected under 35 U.S.C. 102(b) as being anticipated by Swanson et al. US Patent No. 6,494,880.

As to claims 1 and 23, Swanson et al. disclose a system and method for controlling power in an electrosurgical probe 208, the system comprising:

a radiofrequency source and circuit that delivers RF energy to a tissue, through the probe; and

a regulator circuit, which controls the RF energy delivered to the tissue during a medical procedure as claimed (see Figs. 1-4).

Note: the recitation that the 'probe delivers RF energy to the cornea' as recited in the claims is directed to an intended use. The applicant's written description further fails to disclose a structure of the probe, which is configured/adopted to be placed on the cornea. Nevertheless, the system of Swanson et al is capable for delivering RF energy to the cornea. Hence, Swanson et al. functionally anticipate the recited claim language.

As to claims 2, 5, 6, 8-12, 14-20, 22, 24, 27, 28, 30-34, 36-42, 44, 67, 70, 71, 73 and 76-78, Swanson et al. measure and determine a profile in physiological parameters of the tissue, such as tissue temperature and impedance, and as a result regulate the RF energy delivered to said tissue as claimed (see col.17, lines 18-59; col. 18, lines 44-60; and claims 1-7 of Swanson et al).

As to claims 3, 4, 25, 26, 68, 69, 74 and 75, Swanson et al. measure the current and voltage delivered to the tissue during treatment to provide a feedback control to the regulator circuit (see col. 7, lines 34-46). Note: the applicant employs a voltmeter 70 and an ammeter 68 to measure the voltage and current delivered to the tissue, respectively (see Fig. 5 of the instant application).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 13, 21, 29, 35, 43 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swanson et al. in view of Farin et al. US Patent No. 6,348,051.

Although Swanson et al., described above, measure tissue impedance, they do not teach a means for measuring tissue moisture. However, the applicant's written description fails to teach a particular mechanism or structure for measuring tissue moisture. In page 22, lines 5-9 of the instant application, the applicant merely recites that "the probe may have a temperature sensor or moisture sensor integrated into the tip."

Farin et al. disclose an alternative surgical probe and methods of use in which HF electrical energy is directed to at tissue, through the probe. They further teach that

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moisture of the tissue can be determined by measuring current through the tissue, i.e. tissue conductance/impedance (see col. 1, line 66 to col. 2, line 4).

Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to use the tissue impedance/conductance data measured by Swanson et al. in view of Farin et al. in order to determine moisture of the tissue as claimed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahmed M. Farah whose telephone number is (571) 272-4765. The examiner can normally be reached on Mon, Tue, Thur and Fri between 9:30 AM 7:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marmor II Charles can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ahmed M Farah/  
Primary Examiner, Art Unit 3735

June 4, 2008.